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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/754,879 | 01/05/2001 | Christian F. Bayne | D5407-111 304-22404-US | 5401 |
| 25397 | 7590 | 04/14/2005 | EXAMINER | |
| DUANE, MORRIS, LLP 3200 SOUTHWEST FREEWAY SUITE 3150 HOUSTON, TX 77027 | | | THOMPSON, KENNETH L | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3672 | |

DATE MAILED: 04/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/754,879

Applicant(s)

BAYNE ET AL.

Examiner

Kenn Thompson

Art Unit

3672

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 December 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2, 7, 8, 12-14 and 20 is/are allowed.
- 6) ☒ Claim(s) 1, 3-6, 9-11 and 16-19 is/are rejected.
- 7) ☒ Claim(s) 15 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 6 August 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The indicated allowability of claims 3 and 10 is withdrawn in view of the newly discovered reference to Kobylinski, U.S. 6,298,921 and Terry et al., U.S. 6,296,066. Rejections based on the newly cited reference follow.

Drawings

The drawings are objected to because the space between the alignment flats 82 and 84 should be recessed from the outer circumferential edge of the housing; the vertical line through the dogs 56 (see spec. pg 18, lines 8-11) and 140 should be removed since it gives the appearance of two separate elements; reference 128 is used in figure 2a and 3a to represent two different parts; and the interaction between the orientation sub 46, crossover 86 and alignment slot 84 is not clearly shown. The slot 84 appears to be on sub 46 with crossover 86 held axially between the sub 46 and housing 72; the specification, on page 19, requires the alignment flat to be on the crossover 86.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the

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renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

The disclosure is objected to because of the following informalities:

On pages 22, line 5, "103" should be changed to 104 and "101" should be changed to 102.

Claim 3 contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The recitations; "plugging the connection" and "unplugging the connection on a subsequent trip" is not enabled.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 5, 6, 11 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Meynier, U.S. 5,355,952.

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Regarding claim 1, Meynier discloses in figures 2-4 attaching at least one auxiliary conduit (2) to a downhole assembly (5), providing a connection (at 6,7) to the conduit; running in the downhole assembly with the conduit to a desired location in the well; tagging into (6) the downhole assembly and the connection (7) of the conduit downhole on at least one subsequent trip into the well with a tubular (9) having at least one auxiliary cable (10) extending along the tubular's length (col. 4, lines 44-47) from the surface; communicating (via 4,8,15,16) through the auxiliary conduit between the surface and the downhole assembly on a real time basis.

As to claim 5, Meynier discloses selectively locking any connection (7,8) resulting from the tagging in.

As to claim 6, Meynier discloses configuring the auxiliary cable (10) adjacent the downhole assembly (5) in a manor permitting monitoring.

As to claim 11, Meynier discloses using the auxiliary cable (10) to operate a portion (13) of the downhole assembly.

As to claim 16, Meynier discloses running in at least one cable (8) and at least one conduit (14) auxiliary to the downhole assembly (5) securing the cable to the conduit.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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Claims 1, 3 and 4 are rejected under 35 U.S.C. 102(e) as being anticipated by Kobylinski, U.S. 6,298,921.

Regarding claim 1, Kobylinski discloses attaching at least one auxiliary conduit (38) to a downhole assembly (12), providing a connection (20) to the conduit; running in the downhole assembly (12) with the conduit to a desired location in the well; tagging into the downhole assembly and the connection of the conduit downhole on at least one subsequent trip into the well (col. 2, lines 15-22) with a tubular (38) having at least one auxiliary cable (34,33) extending along the tubular's length from the surface; the auxiliary cable (34,33) being inherently capable of communications between the surface and the downhole assembly (12) on a real time basis (col. 1, lines 25-29).

Regarding claim 3, as best understood by the Examiner, Kobylinski discloses all the claimed limitations plugging (18) the connection during the running in of the downhole assembly and auxiliary conduit, unplugging the connection with another trip into the well (col. 1, lines 15-22; multiple connections permitting lowering the device).

As to claim 4, Kobylinski discloses tagging in without rotation (col. 6, lines 25-29).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 9, 10 and 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kobylinski, U.S. 6,298,921 in view of Terry et al., U.S. 6,296,066.

Regarding claims 9, 10 and 17-19, Kobylinski discloses an external through (20). Crawford et al. discloses all the claimed subject matter except for the use of fiber optic as the cable and to measure. Terry et al. teaches use of fiber optics to measure a condition (col. 11, lines 9-26) to provide a broad band width transmission and eliminate use of additional sensors. It would have been obvious to one having ordinary skill in the art at the time of the invention to arrange for the communicating cable disclosed by Kobylinski to be fiber optic as taught by Terry et al. since the use of fiber optic communication means being well known in the art.

Allowable Subject Matter

Claims 2, 7, 8, 12-14 and 20 are allowed.

Claim 15 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:

The prior art of record does not disclose or suggest all the claimed subject matter including tagging into the downhole assembly on a subsequent trip with production tubing.

The prior art of record does not disclose or suggest all the claimed subject matter including using a gravel pack screen and packer for the downhole assembly extending the cable or conduit through the packer to the connection.

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The prior art of record does not disclose or suggest all the claimed subject matter including running the auxiliary cable in a U-shaped path so as to provide a pair of connections, extending the U-shaped path to the surface as a result of the tagging, an auxiliary cable attached to a tubular run in from the surface, into a respective connection on a subsequent trip into the wellbore.

Response to Arguments

Applicant's arguments filed 10 December 2004 have been fully considered but they are not persuasive.

Applicant argues the prior does not disclose the tubular extending from the surface and having at least one cable extending along the tubular's length from the surface.

The claims do not require the tubular to extend from the surface. The claims require a cable to extend along the tubular's length and from the surface, not a cable extending along the tubular's length and the tubular extending from the surface.

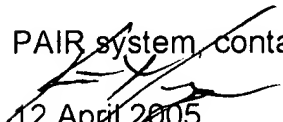
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenn Thompson whose telephone number is 703 306-5760. The examiner can normally be reached on 7:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David J Bagnell can be reached on 703 308-2151. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



12 April 2005
KT